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REMARKS

Claims 1-14 and 16-18 are currently pending. Claims 1, 8, 10, 11, 13, 14, and 16-18 have been amended for clarification purposes only. It is respectfully submitted that no new matter has been added.

The Patent Office object to claim 16 as to being of improper dependent form.

Applicant has rewritten claim 16 in independent form incorporating the subject matter from former base claim 1. It is respectfully submitted that no new matter has been added and that claim 16 is now in proper independent form.

The Patent Office rejected claims 8, 9, 13, 14, 16, and 17 under 35 U.S.C. 112, second paragraph, as being indefinite.

Claims 8, 13, 14, and 17 have been amended for clarification purposes only. It is respectfully submitted that no new matter has been added and that claims 8, 9, 13, 14, 16, and 17 are clear and definite.

The amendment to claim 16 noted above is believed to overcome the rejection under 35 U.S.C. 112, second paragraph.

Prior Art Rejections

The Patent Office rejected claims 1-14, 16, and 17 under 35 U.S.C. 103(a) as being unpatentable over Bishop, U.S. Published Patent Application No. 2004/0243520, in view of Martinez, U.S. Published Patent Application No. 2003/0159071.

Bishop relates to a system and method for conducting electronic commerce. A user is provided with a token such as a smart card containing a digital certificate for authenticating the user to the network. A digital wallet can be used to provide enhanced security and also to fill in forms automatically.

The Patent Office on page 4, lines 11-19, of the Office Action dated March 27, 2007, asserted as follows:

Regarding claim 1, Bishop teaches a system and method for completing electronic transactions utilizing a digital wallet interacting with merchant sites (see at least: abstract, 0015, Fig. 2 and 5-8). More specifically, Bishop teaches *displaying at least one data entry field to a user* during an electronic transaction (see at least: Fig. 8 (note #804), 0065). Bishop also teaches *displaying a user selectable icon* in the system tray that *provides, to the user, access to an electronic wallet application, for transfer of data*

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into the data entry field, in response to user selection of the icon (see at least: 0015, 0057, 0059, 0061, 0063, 0065, Fig. 5 (#502), Fig. 8). Though Bishop teaches all of the above, Bishop does not expressly teach automatically displaying the selectable icon in response to user selection of the data entry field.

Bishop, in reference to Figure 8, discloses “when the user indicates a desired purchase at a merchant site 702, the checkout user interface 802 of the digital wallet is displayed” (paragraph 0063). Although Bishop does not clearly disclose how the user indicates a desired purchase, presumably, the user may select a “continue to checkout” field in completing the purchase window 804 to display the digital wallet 802. Bishop, in paragraph 0065, merely discloses that HTML forms may be filled or pre-filled for users and that information is collected and stored for users. Data entry fields are shown in Figures 5, 6, and 8 in Bishop.

Bishop discloses a digital wallet tool bar 502 (Figures 5 and 7) that when selected, causes a shopping directory page 602 or a checkout user interface 802 to be displayed (paragraphs 0062, 0063). Bishop, in paragraph 0057, discloses an activator in that form of object code that may be presented as a single icon to enable a user to trigger the appearance of the wallet toolbar. Bishop, in paragraph 0061, discloses a digital wallet icon that when invoked by a user causes the digital wallet toolbar to be displayed.

Bishop does not disclose the claimed subject matter of “automatically displaying a user selectable icon in response to user selection of the data entry field.” There is no relationship disclosed by Bishop between user selection of a data entry field and the displaying of a user selectable icon in response. The Patent Office is correct in asserting that Bishop does not expressly teach automatically displaying the selectable icon in response to user selection of the data entry field. Furthermore, Bishop does not impliedly teach or suggest displaying the selectable icon in response to user election of the data entry field.

The Patent Office asserted Martinez effectively teaches automatically displaying a selectable graphic in response to user selection of the data entry field (page 5, lines 6-8, of the Office Action dated March 27, 2007) and that the wallet pop-up box acts analogously to the icon of Bishop as it provides the user access to the wallet application.

Martinez discloses “upon field activation (41), such as the mouse or pointer device

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moving over a password field, a user clicking into a password field, or other activation such as a user right-clicking a pointer or mouse over a field, the wallet pop-up dialogue is displayed (42)” (paragraph 0053). Martinez’s wallet is concerned with the management of multiple passwords using a single wallet master key (e.g., Figure 6(d)) in which “an electronic password wallet provides quick and easy access to any number of password-protected computer applications and web sites in a secure fashion...” (paragraph 0021).

Bishop teaches that when a user activates a digital wallet icon, a digital wallet toolbar is displayed. If the wallet pop-up dialogue of Martinez, asserted by the Patent Office to be analogous to an icon, were to be substituted for the icon of Bishop, then the result may be a wallet pop-up dialogue that, when activated, causes the display of a wallet toolbar. If the wallet pop-up dialogue of Martinez were to be substituted for the wallet toolbar of Bishop, then activation of an icon may result in the bringing up of the wallet pop-up dialogue.

Expressed another way, Bishop discloses

icon → wallet toolbar → shopper directory page (or, checkout page)

where Bishop is silent as to whether the icon is a permanent feature or is somehow invoked, while Martinez discloses

data entry field → wallet pop-up dialogue.

Substituting a wallet pop-up dialogues for an icon may result in

data entry field → wallet pop-up dialogue → wallet toolbar → shopper directory page (or, checkout page).

This presumed result would be awkward, and more importantly, would fail to make obvious claim 1 where **data entry field → icon → electronic wallet application.**

As modification of Bishop by Martinez would not result in the subject matter found in claim 1, claim 1 is allowable over Bishop in view of Martinez. As claims 2-14 and 16 depend from claim 1, claims 2-14 and 16 are also allowable.

As claim 17 is similar to claim 1, claim 17 is also allowable over Bishop in view of Martinez.

The Patent Office rejected claim 18 under 35 U.S.C. 103(a) as being unpatentable over Bishop in view of Martinez and further in view of Atsmon, U.S. Patent No. 6,607,136.

Atsmon discloses (column 69, lines 1-13) as follows:

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Referring now to FIG. 29, the smart e-wallet application (which includes the e-wallet client software and the electronic card software) is a single tray application that is represented as an icon in the System Tray by the Windows OS if the application is active. Typically, the smart e-wallet application opens automatically on start-up. Of course, the user can turn off (i.e., close) the e-wallet application at any time after it has been opened by, for example, right clicking the tray icon and selecting "Exit." The icon will then promptly disappear from the system tray. Conversely, the user can manually open the e-wallet application from the Program Menu, or if a short cut has been provided on the desktop.

Atsmon clearly does not remedy the deficiencies of Bishop and Martinez. Thus, claim 18 is allowable over the cited references.

The Patent Office is respectfully requested to reconsider and remove the rejections of the claims under 35 U.S.C. 103(a) based on Bishop and Martinez or Bishop, Martinez, and Atsmon, and to allow all of the pending claims 1-14 and 16-18 as now presented for examination. An early notification of the allowability of claims 1-14 and 16-18 is earnestly solicited.

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Respectfully submitted:

Walter Malinowski

Walter Malinowski

Reg. No.: 43,423

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Date

Customer No.: 29683

HARRINGTON & SMITH, LLP

4 Research Drive

Shelton, CT 06484-6212

Telephone: (203) 925-9400, extension 19

Facsimile: (203) 944-0245

email: wmalinowski@hspatent.com

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